

### **REMARKS/ARGUMENTS**

The Office Action of April 21, 2005, has been carefully considered.

It is noted that claims 3 and 4 rejected under 35 U.S.C. §102(b) or, in the alternative, under 35 U.S.C. §103(a) over ES 2,101,612 (hereinafter ES '612).

In view of the Examiner's rejection of the claims, applicant has amended the specification and claims to more clearly bring out the feature that the rebates extend along substantially the entire length of the cutting wheel handle so as to reduce the vibration frequency of the handle, as well as the magnitude of the vibrations. Applicant submits that the introduction of this language into the specification does not entail new matter since the drawings originally filed with the application clearly show in Fig. 2 that the rebates extend for substantially the entire length of the cutting wheel handle 6.

It is respectfully submitted that the claims now on file differ essentially and in an unobvious, highly advantageous manner from the constructions disclosed in the reference.

Turning once again to ES '612, this reference was discussed in detail in the last filed Amendment. In order to avoid redundancy, applicant incorporates that discussion herein by reference. Additional comments on the reference follow.

Addressing first the rejection under 35 U.S.C. §102(b), the statute requires that for anticipation, the reference must show each and every feature recited in the claims. Applicant submits that ES '612 clearly does not disclose rebates that extend along substantially the entire length of the cutting wheel handle 30. Clearly, the recessed part 32 in the handle extends along only a portion of the handle 30, as shown in Fig. 1. This portion is substantially less than the overall length of the handle 30 and is disclosed by ES '612 to be no more than  $\frac{1}{4}$  or  $\frac{1}{2}$  the length of the handle 30. Furthermore, as shown in Fig. 1 of ES '612, the portion of the handle 30 which has the recesses 32 ends at a shoulder. This is evident from Fig. 1 of ES '612 since the portion of the handle 30 which is inserted in the bearing 33 clearly has a small diameter than the remainder of the handle 30 which extends from the bearing 33 down to the cutting tool 2.

Thus, applicant respectfully submits that there is absolutely no disclosure of rebates that extend over substantially the entire length of the cutting wheel handle as recited in the presently claimed invention. Furthermore, there is no acknowledgement by the reference of any alleviation of vibrations by providing rebates.

Applicant further respectfully submits that the claimed invention is not obvious over ES '612. The Examiner states that "it would have been an obvious matter of design choice at the time of (sic) the invention was made to a person of ordinary skill in the art to extend the rebates over substantially the entire length of the cutting wheel handle instead of the portion as shown in Fig. 1 for the purpose of allowing height adjustment of the cutting wheel relative to the workpiece support because applicant does not disclose that the rebates extending for substantially the entire length of the handle provides any advantage, is used for a particular purpose, or solves a stated problem." Applicant submits that the Examiner is merely using hindsight in making his rejection. This of course is inappropriate. Applicant submits that the Examiner must demonstrate the motivation for making the argued modification. There is absolutely no such motivation or teaching provided by ES '612. The Examiner's statements regarding height adjustments of the cutting wheel is merely conjecture and has no support in the relied upon reference, or any other source cited by the Examiner. Applicant submits that there must be some motivation or teaching for making the change argued by the Examiner. Without such teaching, the Examiner's position is merely hindsight reconstruction.

One of the main objectives of the present invention, as pointed out in the specification, is to reduce the vibration transmitted via the cutting wheel handle. The problems with the prior art are discussed, for example, on page 2, line 17-page 3, line 22, of the specification. That addressing the vibration problem is one of the main objectives of the present invention is indicated in the paragraph bridging pages 3 and 4 of the specification. Furthermore, the paragraph beginning on line 4 of page 4 of the specification clearly states that the longitudinal rebates have the aim "to reduce the frequency of vibration during the scoring process..." Although the specification does not specifically state that the rebates extend over substantially the entire length of the handle, this is clearly what is disclosed in the drawings originally filed with the application. Thus, it is respectfully submitted that the rebates extending for substantially the entire length of the handle has the specific advantage of reducing vibration and this is believed to be clearly disclosed in the specification.

Furthermore, as previously pointed out, the handle 30 of ES '612 is a smaller diameter section that extends over only a  $\frac{1}{4}$  to  $\frac{1}{3}$  of the length of the handle, and a larger diameter section which makes up the majority of the handle. This provides a shoulder against which the bearing

33 rests when the arm 30 is inserted therein. Therefore, the Examiner's reasoning that the rebates can extend over the entire length of the handle 30 to allow height adjustment would not be feasible. Simply increasing the length of the rebates would not take away the shoulder of the arm 30 shown in Fig. 1 of ES '612. Thus, there would be no possibility for making height adjustments as argued by the Examiner. Without the Examiner's argued motivation of making height adjustments being present, there is no motivation to extend the rebates as suggested by the Examiner.

Thus, applicant respectfully submits that the presently claimed invention is not rendered obvious by ES '612.

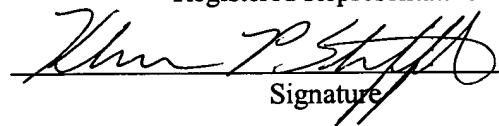
In view of these considerations, it is respectfully submitted that the rejection of claims 3 and 4 under 35 U.S.C. §102(b) or, in the alternative, under 35 U.S.C. §103(a) over the above discussed reference is overcome and should be withdrawn.

Reconsideration and allowance of the present application are respectfully requested.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on August 12, 2005:

Klaus P. Stoffel

Name of applicant, assignee or  
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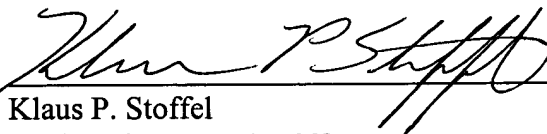
  
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August 12, 2005

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Respectfully submitted,



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